



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/026,736	03/05/93	ALIZON	M 3495.0010-12

18M2/0103
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER
1300 I STREET, N. W.
WASHINGTON, DC 20005-3315

EXAMINER EFTSFF, I	
ART UNIT	PAPER NUMBER

DATE MAILED: 1806

01/03/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/026,736

Applicant(s)

Alizon et al.

Examiner

FEISEE

Group Art Unit

1806



☒ Responsive to communication(s) filed on Sep 22, 1995

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11, 13, and 15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11, 13, and 15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/158,652.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1806

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The only rejection outstanding is discussed below.

Claims 11,13 and 15 remain rejected under 35 U.S.C. § 102(b) as being
5 anticipated by Kalayanarman or Schupbach et al as evidenced by Arya et al.,
Wong-Staal and Cohen et al. for reasons previously set forth.

Applicant argues that the examiner has erroneously interpreted isolated to mean separated from the body, and in doing so has made the statement that "isolated" is equivalent to "separated from the body". The examiner has
10 interpreted the language "isolated" in its broadest sense as is incumbent on her to do, especially in view of the fact that there is no degree of purity anywhere in the claims or in the specification. If the antibodies of the claims are isolated so as to be useful for diagnostic applications, than certainly the product of Kalayanarman and Schupbach et al. fall in this category. Nevertheless, the
15 definition of "isolate" in Stedman's Medical Dictionary, 25th edition is " To separate, to set apart others", "To free from chemical contaminants". Clearly, the separation of the serum from other contaminants in the blood, as well as from the host meets this definition.

Applicant also argues that the references of Kalayanaraman and
20 Schupbach do not expressly teach the claimed antibodies, however, the three

Art Unit: 1806

evidentiary references teach that in the serum of an infected individual, there undeniably exists antibodies which bind to exactly the sequences recited in the claims. These references prove that the claimed antibodies were already present known in the prior art.

5 Applicant further argues that the anticipatory references are not enabling because the sequences were not known. However, because the serum has the specificities which bind to the sequence, knowledge of the sequence is not necessary, it is the antibodies and not the sequence which is being claimed. The anticipatory references teach that an infected individual
10 possesses these specificities within his repertoire of antibodies.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

15 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED
20 STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Serial Number: 08/026,736

-4-

Art Unit: 1806

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lila Feisee whose telephone number is (703) 308-2731. The examiner can normally be reached on Mondays-Fridays from 9:00-5:30.

5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311. The fax number for this Group is (703) 308-4227.


10

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15

20

Lila Feisee/lf
January 2, 1996



LILA FEISEE
PRIMARY EXAMINER
GROUP 1800